

Docket No. IVGN 491

Warden *et al.*
Serial No. 10/749,348

REMARKS**The Claimed Invention**

Provided is a waveguide for detecting light scattering particles, a method for detecting an analyte using light scattering particles and an apparatus that comprises the waveguide, an illuminating system and a scattered light detection system.

The Pending Claims

Prior to consideration of the following Response to Restriction Requirement, Claims 1-48 are pending. Claims 1-23 are directed to a waveguide for the detection of light scattering particles. Claims 24-40 are directed to a method for detecting an analyte using the light scattering particles and the waveguide. Claims 41-48 are to an apparatus for illuminating a planar waveguide and detecting scattered light produced by scattered light detectable particles in the waveguide.

The Office Action

Claims 1-48 are restricted.

Amendments

No claims have been canceled, added or amended.

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RESPONSE TO RESTRICTION REQUIREMENT

In the response that follows, the Examiner's Election/Restriction of the Applicant's claimed invention is provided in full text, as identified by indented small bold print, followed by the Applicants response.

35 U.S.C. 121 Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121

- I. Claims 1-23, drawn to a waveguide, classified in class 385, subclass 141.
- II. Claims 24-40, drawn to a method for detecting an analyte in a sample on the waveguide, classified in class 435, subclass 5.
- III. Claims 41-48, drawn to an apparatus for illuminating a planar waveguide and detecting scattered light produced by scattered light detectable particles in the waveguide, classified in class 385, subclass 129.

Applicants respectfully traverse the above restriction requirement and request reconsideration, but as required by CFR 1.143 Applicants provisionally elect group II. Applicants retain the right to prosecute the non-elected claims in a future continuation or divisional application

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and II are related as product and process of use. The Inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using the product (MPEP 806.05(h)). In the instant case the detecting step can be eliminated and the claimed waveguide structure can be coupled to a display unit.

Applicants respectfully disagree because the detectable scattered light is produced in the waveguide whether or not is further coupled to a display unit. When the particles are illuminated there is a detectable signal produced.

The waveguide is used to illuminate and detect the light scattering particles. These are the same particles used to detect the analyte in the method claims. Thus, both the particles and

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the waveguide is a unify aspect between the claims of group I and the claims of group II. Applicants respectfully request that these two groups of claims be rejoined.

Inventions of Group III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the claimed light detectable particle can be any size and does not need to be bound to an analyte. The subcombination has separate utility such as light scattering device which can couple to a display unit.

Applicants respectfully disagree with this analysis. Rather than a combination and subcombination the claims in group III are an additional embodiment that builds on the embodiment in group I. In this instance, the waveguide further comprises an illuminating system and a scattered light detection system. Applicants respectfully request that the claims of group I and group III be rejoined. Applicants further request that the group II be rejoined with these claims.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated proper.

Separately, Applicants request that if the Examiner finds the subject matter of group II patentable that the search be expanded to include the subject matter of Group I.

Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Group I, restriction for examination purposes as indicated is proper.

As stated above, Applicants request that if the Examiner finds the subject matter of group II patentable that the search be expanded to include the subject matter of Group III.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicants respectfully request that the waveguide and apparatus claims of groups I and III be rejoined with the method claims of group II.